

**REMARKS**

Prior to this response, claims 13, 33-50, 57-66, and 76-83 were pending in the application. Claim 13 has been amended in the above amendments. Claims 34 and 57 have been canceled, and claim 84 has been added. Accordingly, claims 13, 33, 35-50, 58-66, and 76-84, of which claims 13, 76, and 83 are independent, are still pending in the application.

**Claim Rejections Under §103:**

Paragraph 3 of the Action rejects claims 13, 33-48, 57-64 and 76-83 under 35 U.S.C. §103(a) as being unpatentable over Gregorek (U.S. Patent 5,557,658) in view of Hidary (U.S. Patent 5,852,775). Claims 34 and 57 have been canceled thereby rendering the rejection moot as to these claims. Applicant therefore respectfully requests withdrawal of the rejection as to claims 34 and 57. With respect to the remaining claim, Applicant respectfully traverses this rejection for at least the reasons stated below.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” *See* MPEP §706.02(j).

In this case, the Action fails to make out *prima facie* case of obviousness because Gregorek and Hidary, alone or in combination, do not teach each and every limitation of the claims. Claim 13 has been amended to include the limitation of claims 34 and 57. Accordingly, each of independent claims 13, 76, and 83 include replacing the ring tones in a ring back signal with short advertisements. With respect to claims 76 and 83, the previous Action stated that the claims do not sufficiently recite replacing the rings of a ring back signals with a series of short advertisements as opposed to replacing the entire ring back signal. Applicant respectfully disagreed because, for example, claim 76 recites “ . . . cause the plurality of short advertisement associated with the source to replace the rings of a ring back signal.” Accordingly, Applicant asserted, and still asserts that the claims cite sufficient detail.

The previous Action further stated that the ring back signal is also short and that an advertisement that replaced the ring back signal would therefore be short. Applicant noted that this statement apparently admits Gregorek teaches replacing the ring back signal and not the individual ring tones. Applicant further noted that while a ring back signal may be short, it is clearly not as short as the ring tones. Thus, a continuous message of 5-30 seconds as taught in Gregorek clearly would not be sufficient to achieve the invention as claimed in claims 76 and 83, and now 13.

The current Action does not address these arguments. Rather, the current Action states that claims 76 and 83 are rejected for the same reasons as claims 13, 34, and 57 (now amended claim 13); however, claim 34 does not appear to be rejected. Claim 34 previously recited:

“The telecommunications advertising system of claim 57, wherein  
the processor is further configured to associate a plurality of short

advertisements with the source and to cause the advertisement associated with the source to replace the rings of a ringback signal that would normally be routed to the source.”

Claims 33-36 were rejected together, however, the rejection does not specifically address the limitations of claim 34. The cited text in the rejection adds nothing to the text cited previously and addressed in prior responses. Accordingly, Applicant believes that for the second straight time, the Action fails to overcome Applicant’s arguments in this regard.

For example, in addition to the above examples, paragraph 5 of the previous Action attempted to address Applicant’s previous argument that Gregorek does not teach replacing the ring tones of the ring back signal with short advertisement, but rather that Gregorek teaches replacing the entire ring back signal with one long message that is 5-30 seconds long. This argument was relevant to claims 34 (now 13), 76, and 83 and any claims that depend therefrom. The Action did not attempt to refute this position, but rather stated that “[t]his is irrelevant to the claimed invention.” Applicant of course respectfully disagreed, because as Applicant noted the limitations at issue are expressly contained in three separate claims (34 (now 13) 76, and 83), two of which (claims 76 and 83) are independent claims. Thus, Applicant noted that the limitations were quite relevant. The current Action provides no response.

Applicant also noted that it is an unquestioned tenant of patent law that in order for a reference to render a claim unpatentable, it must teach each and every element of the invention as claimed. Moreover, “the identical invention must be shown in as complete detail as contained in the . . . claim.” (See MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Applicant noted that the art cited in the previous

Action, including Gregorek, did not teach the above limitation and that the Action made no assertion to the contrary, but rather tried to overcome the deficiencies in the cited references by stating that it is not relevant to the claimed inventions, which is clearly not the case. Accordingly, Applicant asserted that the statement of paragraph 5 of the prior Action admitted that this limitation is not met by Gregorek, but rather attempted to provide an improper basis for an anticipation or obviousness rejection. The current Action does not address these arguments.

As with the last Action, the present Action again puts forth no new grounds for rejecting claims 34 (now 13), 76, and 83. In particular, the Action does not assert that Hidary teaches the above limitation of claims 13, 76, and 83. Accordingly, Applicant asserts that claims 13, 76, and 83 are allowable over the art of record for the reasons stated previously and restated above. Applicant therefore respectfully requests withdrawal of the rejection as to claim 13, 76, and 83. Applicant also respectfully requests withdrawal of the rejection as to claims 33-48, 57-64 and 76-82, since these claims ultimately depend from claims 13 and 76.

Paragraph 4 of the Action rejects claims 49-50 and 65-66 under 35 U.S.C. §103(a) as being unpatentable over Gregorek in view of Hidary, in further view of Creamer (U.S. Patent 6,028,917). Claims 49-50 and 65-66 ultimately depend from claims 13 and 76 and are therefore, allowable for at least these same reason unless Creamer can make up for the deficiencies of Gregorek and Hidary, which it cannot. Applicant therefore respectfully request withdrawal of the rejection as to claims 49-50 and 65-66.

**New Claims:**

New claim 84 has been added in the above amendments. Applicant believes that new claim 84 does not introduce new matter and is fully supported by the specification. Claim 84 depends from claim 13 and is therefore allowable for at least the same reasons as claim 13.

**CONCLUSION**

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. No new claim fees are believed to be necessitated by this response. The Examiner is requested to charge any additional fees that may due with this response to deposit account 13-0480.

Respectfully submitted,

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